

REMARKS

A telephone interview was conducted between the Examiner and her supervisor and applicants' attorney. Applicants confirm the Examiner's interview summary accurately reflects the discussion at the interview.

After entry of this amendment, claims 1-23, 25-28 and 30 are pending.

I. Status of the Claims

Claims 2, 4-9, 11, 13-15, 18-22, and 25-28 have been amended to use the definite article for dependent claims, *i.e.*, "the" instead of "a".

Claim 7 is amended clearly to define receptor binding affinity. Support for this amendment can be found in the paragraph beginning on e.g., page 14, line 23 of the specification.

Claim 23 is amended to define the intended use of the composition. Support for these amendments is found on e.g., page 1, lines 1-8, the paragraphs spanning page 10, line 3 - page 11, line 2, page 13, lines 1-9, page 19, line 21 to page 20, line 2, and page 20, lines 18-19, and in Examples 1-3.

New claim 30 follows a similar format to existing claim 7 but specifies a higher binding affinity. Support for newly added claim 30 may be found in the paragraph beginning on page 14, line 23 of the specification.

No claim amendment should be construed as acquiescence in any ground of rejection.

Paragraph numbering in comments below correspond to the Office Action mailed November 9, 2006.

II. Enablement-Based Rejections

12. In the Office Action mailed November 9, 2006, the Examiner took the view that claim 23 does not reasonably provide enablement for all pharmaceutical compositions encompassed by

the claim. In particular, the Examiner takes the view that when the term "pharmaceutical" is used in the preamble of the claim, its intended use as a pharmaceutical must be shown in the application. According to the Examiner's assessment, the specification does not provide enablement for prevention of any disease and any species by administration of the pharmaceutical of claim 1 by any means. Applicant respectfully disagrees that there is any requirement for a pharmaceutical composition to recite a use or for a composition that does not recite a use for enablement to be shown for every possible use.

When a compound or composition is not limited by any recited use, any enabled use that would reasonably correlate with the entire scope of that claim is sufficient to preclude a rejection for nonenablement based on how to use...In other words, if any use is enabled when multiple uses are disclosed, the application is enabling for the claimed invention.

MPEP § 2164.01(c).

Nevertheless, to expedite prosecution, claim 23 has been amended to provide a recitation of intended uses of the composition, *i.e.*, to stimulate osteogenesis, chondrogenesis, and/or wound healing. The recited uses of claim 23 are therapeutic rather than preventative in nature.

Applicant further notes that the polypeptide variants of claim 1 possess therapeutic pharmaceutical activity of the type claimed as evidenced by the examples demonstrating that the polypeptide variants effectively induce bone growth in mice. In addition, the specification provides extensive guidance to convey to the skilled worker with reasonable certainty that the claimed invention can in fact be carried out over its whole ambit.

The Examiner also objected to claim 23 because the claim did not recite any pharmaceutically acceptable carrier or excipient. Solely to expedite prosecution, the claims has been amended to specify a physiological competitive additive described at page 19, in the last paragraph of the specification.

III. Indefiniteness-Based Rejections

14. Claim 7 is rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Applicant has amended claim 7 to replace the term "essentially the same" with a defined receptor affinity. In view of the amendments, Applicant respectfully requests withdrawal of the rejection.

15. Claims 2, 4-9, 11-15, 17-23, and 25-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention by using "a" in the preamble of dependant claims. Applicant has amended the article "a" in these claims except for claims 12, 17, and 23. with "the" as suggested by the Examiner, and respectfully request withdrawal of the rejection. Here the indefinite article qualifies a noun not recited in claim 1 for which use of a definite article would lack antecedent basis.

16. Claim 23 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, specifically for failing to identify the intended use of the claimed pharmaceutical. As described in the preceding section of this paper, Applicant has amended claim 23 to recite specific therapeutic uses for the pharmaceutical. Applicant respectfully submits that this amendment addresses the Examiner's concerns and request withdrawal of the rejection.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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